

Atty. Docket No. 2001-0138-03  
USSN 10/629,364

**Remarks**

Claims 25-31 remain pending in the above captioned application. Claims 25-27 and 31 stand rejected and claims 28-30 are objected to by the Examiner.

Claims 25-31 stand provisionally rejected for double patenting under 35 U.S.C. §101 for claiming the same invention as claims 23-28 in United States patent Application Ser. No. 10/684,016 and claims 23-28 of United States Patent Application Ser. No. 09/953,026.

United States Patent Application Ser. No. 09/953,026 has issued as United States Patent No. 6711202 on March 23, 2004, and does not include claims 23-28.

Claim 23 in United States Patent Application Ser. No. 10/684,016 does not contain the same recitations as claim 25 of the present application, having been amended in a Preliminary Amendment filed on October 10, 2003. Therefore, the dependent claims 26-31 in the above captioned application are also not the same as claims 24-28 of the '016 application.

For the above stated reasons the Examiner's rejection of claims 25-31 for double patenting is not proper and applicants respectfully request that this rejection be withdrawn and claims 25-31 be allowed.

Claims 25-31 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner has taken the position that "the terms 'fabricating', 'operating' and 'creating' are vague and indefinite as the claim fails to recite how these processes are performed.

Applicants submit that the utilization of gerunds such as "operating" "fabricating" and "creating" are entirely permissible in method or process claims as specifically provided for in 35 U.S.C. §112, sixth paragraph as a "step for performing a specified function without the recital of structure, material, or acts in support thereof, ... ." Nevertheless, claim 25 has been amended to recite "using" in lieu of "fabricating" to broaden the claim, since a particular manner of fabricating the electrodes is not material to the claimed invention, which simply requires that such electrodes be used.

As to claim 26 the Examiner has taken the position that the claim is unclear, since the Examiner "questions how operating the electrode" ... would create a porous layer.

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The Examiner's attention is directed to p. 3, line 22 – p. 4, line 4, as an example, where this process step is described.

As to claims 28 and 31 the Examiner has taken the position that the claim is unclear since the Examiner "questions how 'mixing insulating particles and molten metal ...' produces a discharge section of the electrode." The Examiner's attention is directed, for example to p. 19, lines 14-26.

Claims 29 and 30 have been cancelled.

For the above stated reasons the Examiner's rejection of claims 25-28 and 31 under 35 U.S.C., §112, second paragraph, is improper and the Examiner is respectfully requested to withdraw this rejection and allow claims 25-27 and 31.

Claims 25-27 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 3828277, issued to Otto et al. on August 6 1974, entitled INTEGRAL CAPACITOR LATERAL DISCHARGE LASER ("Otto") in view of United States Patent No. 5771259, issued to Dvorkin on June 23, 1998, entitled LASER ELECTRONIC COATING, or JP01-154,577, published on June 16, 1989, entitled DISCHARGE EXCITATION TYPE SHORT PULSE LASER (Yamazaki"). The Examiner has taken the position that "Otto ... teaches a capacitor discharge laser whereby the electrode is coated with a ceramic dielectric layer (abstract) ... Dvorkin ... teaches a laser electrode whereby the electrode is coated with a ceramic dielectric layer (abstract) [and Yamazaki teaches a mica coating layer around an auxiliary electrode for a discharge laser (see constitution)."

The Examiner has also taken the position that the other claimed elements are "conventional" and involve only "optimized dimensions."

Even if the Otto, Dvorkin and Yamazaki references teach what the Examiner indicates they do, which applicants neither concede nor deny, the Examiner has still failed to make a *prima facie* case for obviousness, since not all elements of the claimed invention are found in any of these references or the combination thereof.

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For *prima facie* obviousness all of the claim limitations must be taught or suggested by the prior art.<sup>1</sup> If an independent claim is nonobvious any claim depending from the independent claim is also nonobvious.<sup>2</sup>

None of the Otto, Dvorkin or Yamazaki references teach or suggest that the insulating layer be "porous."

For the above stated reasons the Examiner's rejection of claims 25-17 and 31 under 35 U.S.C. §103(a) is improper and the Examiner is respectfully requested to withdraw the rejection and allow claims 25-27 and 31.

Furthermore for the optimization of a particular parameter recited in a claimed invention to be obvious, it must first be shown that the particular parameter is recognized in the art as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.). See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (prior art suggested proportional balancing to achieve desired results in the formation of an alloy).

For the above stated reasons the Examiner's conclusory statement that "one skilled in the art would have optimized the dimensions," is unsupported by the required foundation noted above, and therefore, improper, and the Examiner is respectfully requested to withdraw the rejection and allow claims 25-27 and 31.

The Examiner has indicated that the subject matter of claims 28-30 would be allowable if amended to address the rejections under 35 U.S.C. §112 and to include the recitations of claims from which these claims depend. Applicants submit that the Examiner's rejections under §112 and §103(a) have been addressed above and that the claims should be allowable without further amendment beyond the amendment to claim 25 noted above.

<sup>1</sup> M.P.E.P. §2143.03. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (must consider all of the claim language).

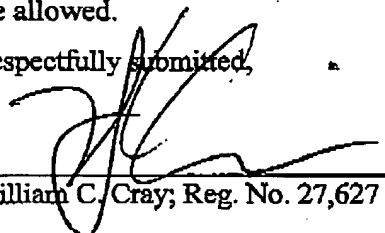
<sup>2</sup> M.P.E.P. §2143.03. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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**Conclusion**

For the above stated reasons, Applicants assert that the claims currently pending, claims 25-28 and 31, should be in a condition for allowance and the Applicants respectfully request that claims 25-28 and 31 be allowed.

Respectfully submitted,

  
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